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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,482	12/29/2003	Brian I. Marcus	EDU.026	8736
28554	7590	08/26/2005	EXAMINER	
VIERRA MAGEN MARCUS HARMON & DENIRO LLP 685 MARKET STREET, SUITE 540 SAN FRANCISCO, CA 94105			HARRIS, CHANDA L	
			ART UNIT	PAPER NUMBER
			3714	

DATE MAILED: 08/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/748,482

Applicant(s)

MARCUS ET AL.

Examiner

Chanda L. Harris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-37, 39-50, 52, 53, 55-58, 61 and 62 is/are rejected.
- 7) ☒ Claim(s) 38, 51, 54, 59-60, 63 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/10/04, 12/14/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

In response to the Amendment filed 11/22/04, Claims 4-63 are pending. Claims 1-3 are cancelled.

Information Disclosure Statement

The information disclosure statements filed 9/10/04 and 12/14/04 fail to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. They have been placed in the application file, but the information referred to therein has not been considered. There are no copies of the foreign patent document and the non-patent literature documents contained in both information disclosure statements.

Claim Objections

1. Claims 4, 13, 17, 24, and 30 are objected to because of the following informalities: "by the child" is repeated twice. Appropriate correction is required.
2. Claim 5 is objected to because of the following informalities: The claim does not have a period at the end. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 9, 17-29, 35, 46, 49, 52-53, 57-58, and 61-62 are rejected under 35

U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The subject matter pertains to a plurality of images presented on the work platform wherein the images presented on the work platform are changed from time to time, the processor being aware of the change of images without the child having to assist in advising the toy that the presented images have been changed.

2. Claims 39-43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The subject matter pertains to wherein the work platform comprises a touch-sensitive electronic display screen electronically and temporarily displaying the plurality of images on the work platform.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 10-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 10 recites the limitation "the educational software" in line 2. There is insufficient antecedent basis for this limitation in the claim.
2. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 11 recites the limitation "the user" in line 3. There is insufficient antecedent basis for this limitation in the claim.
3. Claim 35 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 35 recites the limitation "the touch-sensitive surface" in line 2. There is insufficient antecedent basis for this limitation in the claim.
4. Claim 36-38 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 36 recites the limitation "the educational software" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 4-8, 10, 13-16, 30-34, 36-37, 44-45, 47-48, 50, 55-56 are rejected under 35 U.S.C. 102(b) as being anticipated by Lee et al. (US 4,968,255).

1. [Claims 4,13,30]: Regarding Claims 4,13, and 30, Lee discloses a toy housing supporting a planar work platform on which a child can make selections by causing contact across a planar surface of the work platform, the toy housing enclosing: a speaker (Col.7: 64-66), a processor (Col.2: 56-60), and at least a portion of a sensing system (i.e., detection means, Col.2: 56-60), the sensing system sensing occurrences of contact caused by the child with the work platform and sending information to the processor corresponding to one or more sensed occurrences of contact. In addition, see FIG. 1. Lee discloses a first learning mode wherein the child explores letters, words, numbers or pictures by causing contact with the work platform without there being an indication of an incorrect selection of a letter, word, number or picture. See Col.4: 45-50. Lee discloses a multiple contact learning mode including: a plurality of questions or instructions capable of being output by the speaker, the questions or instructions presenting the child with a problem (e.g., spelling) which can only be

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correctly solved by the child causing contact with the work platform two or more times, the child indicating two or more cognitive selections by causing contact with the work platform two or more times. See Col.4: 21-28. Lee discloses the processor enclosed within the housing receiving information from the sensing system corresponding to the sensed occurrences of contact by the child on the work platform in response to the question or instruction and using the information to evaluate whether the child's cognitive selection as indicated by the child caused contacts with the work platform correspond to a correct solution to the question or instruction, a first audio feedback response output by the speaker where the processor determines that the two or more child caused contacts with the work platform correspond to a correct solution to the question or instruction, the first audio feedback response indicating to the child that the two or more selections by the child correspond to a correct response to the question or instruction, and a second audio feedback response output by the speaker where the processor determines that one or more of the child caused contacts with the work platform does not correspond to a correct solution to the question or instruction, the second audio feedback response indicating that one or more of the selections by the child is something other than a correct solution to the question or instruction See Col.5: 51-68. Lee discloses at least a portion of a sensing system, the sensing system sensing occurrences of contact caused by the child with the work platform and sending information to the processor corresponding to one or more sensed occurrences of contact and sensing the lateral movement of a child-caused contact across a face of the work platform while the contact is maintained with the work platform and sending

information to the processor corresponding to the path of the lateral movement of the child-caused contact across the face of the work platform. See Col.5: 51-68.

2. [Claims 5,14,31]: Regarding Claims 5,14, and 31, Lee discloses wherein in the first learning mode and multiple contact learning mode, the contact with the work surface is object-oriented contact (i.e., blocks). See Col.5: 56-64.

5. [Claims 6,15,32]: Regarding Claims 6,15, and 32, Lee discloses wherein the processor generates questions or instructions with different levels of difficulty. See Col.6: 38-39.

6. [Claims 7,16, 33]: Regarding Claims 7,16, and 33, Lee discloses wherein the processor generates more difficult questions depending on the user having provided correct previous answers. See Col.6: 42-48.

7. [Claims 8, 34]: Regarding Claims 8 and 34, Lee discloses the multi-contact learning mode a second prompt specifically asking the child to try to respond to the question or instruction again (i.e., repeating the requested word to be spelled) in the event a selection by the child does not correspond to a correct response to the question or instruction. See Col.5: 65-68.

8. [Claims 10, 36]: Regarding Claims 10 and 36, Lee discloses wherein at least a portion of the educational software (i.e., memory) is capable of being loaded into the toy by users thereof. See Col.2: 49-55.

9. [Claim 37]: Regarding Claim 37, Lee discloses wherein at least a portion of the educational software is capable of being loaded via a portable memory (i.e., indicia

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disclosure means) capable of being inserted into a portable memory receiving device (i.e., cavity). See Col.3: 6-13.

10. [Claims 44-45]: Regarding Claims 44 and 45, Lee discloses wherein the work platform comprises a touch-sensitive surface (i.e., recess means). See Col.3: 30-34.

11. [Claims 47-48, 50]: Regarding Claims 47, 48, and 50, Lee discloses an alternative learning mode wherein the child explores letters, words, numbers or pictures by causing contact with the work platform without there being an incorrect selection, or indication of an incorrect selection, of a letter, word, number or picture and the toy provides audio feedback to the child when such contact corresponds to the selection of a letter, word, number or picture, the audio feedback relating to the selected letter, word, number or picture. See Col.5: 11-18.

12. [Claims 55-56]: Regarding Claims 55 and 56, Lee discloses wherein in the multiple contact learning mode, the problem can only be correctly solved by the child causing contact with the work platform two or more times in a particular sequence (i.e., spelling), the processor evaluates whether the child's cognitive selections as indicated by the child caused contacts with the work platform and the sequence thereof correspond to a correct solution to the question or instruction, the first audio feedback response is output by the speaker where the processor determined that the two or more child caused contacts with the work platform and the sequence thereof correspond to a correct solution to the question or instruction, and the second audio feedback response is output by the speaker where the processor determines that one or more of the child

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caused contacts with the work platform or the sequence thereof does not correspond to a correct solution to the question or instruction. See Col.5: 49-68.

Allowable Subject Matter

Claims 38, 51, 54, 59-60, and 63 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Citation of Pertinent Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Chan (US 5,088,928)
 - educational/board game apparatus, no without there being an indication of an incorrect selection of a letter
- Brautingham (US 4,189,779)
 - parameter interpolator for speech synthesis circuit
- Sakow (US 5,346,399)
 - sets of letters or display members holes for sensing them
- Nelson (US 4,557,694)
 - a teaching device using an elastomeric array keypad
- Yorozu et al. (US 5,451,178)

-tone plates placed in a recess

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

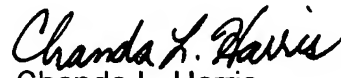
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chanda L. Harris whose telephone number is 571-272-4448. The examiner can normally be reached on M-F 6:30am-4:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jessica Harrison can be reached on 571-272-4449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Chanda L. Harris
Primary Examiner
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